RESPONSE

In response to the Office Action dated May 20, 2004, Assignee respectfully requests reconsideration based on the following remarks. Assignee respectfully submits that all pending claims are in condition for allowance.

The United States Patent and Trademark Office (the "Office") rejected claims 1, 3, 5, 7, and 10-12 under 35 U.S.C. § 102(e) as being anticipated by Grossman (U.S. Patent Pub. No. 1002/0032906 A1), rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Grossman (U.S. Patent Pub. No. 1002/0032906 A1) in view of Trewitt et al. (U.S. Patent No. 6,134,531), rejected claims 8-9 under 35 U.S.C. § 103(a) as being unpatentable over Grossman (U.S. Patent Pub. No. 1002/0032906 A1) in view of Rosser (U.S. Patent No. 6,446,261 B1), and rejected claims 13-14 and 16-22 under 35 U.S.C. § 103(a) as being unpatentable over Grossman (U.S. Patent Pub. No. 1002/0032906 A1) in view of Trewitt et al. (U.S. Patent No. 6,134,531)and in view of Rosser (U.S. Patent No. 6,446,261 B1). The Assignee shows, however, that the pending claims are not fully disclosed in the cited references nor are the pending claims anticipated, nor obviated, by the cited references. Thus, the Assignee respectively submits that the pending claims (claims 1-18 and 23-24) are ready for allowance.

§102 Rejection:

The Office rejected claims 1, 3, 5, 7, and 10-12 under 35 U.S.C. § 102(e) as being anticipated by Grossman (U.S. Patent Pub. No. 1002/0032906 A1). A claim is anticipated only if each and every element is found in a single prior art reference. *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q. 2d (BNA) 1051, 1053 (Fed. Cir. 1987). *See also* DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2131 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, the reference to *Grossman* fails to include every element of the pending claims. The reference to *Grossman*, then, does not anticipate this invention, and Assignee respectfully requests that Examiner Bui remove the 35 U.S.C. § 102 (e) rejection of claims 1, 3, 5, 7, and 10-12.

Grossman does not anticipate the claims of this invention. Claim 15 describes a method for evaluating a performance of a viewer watching a television programming stream. Currently amended claim 1 requires receiving a broadcast of a television programming stream, inserting an associated audio/video (AV) cue into the television programming stream, and presenting the television programming stream and the AV cue to a media delivery system. The method continues to measure a response time, to evaluate performance, and to award an incentive if the viewer responds to the cue. If, however, the viewer does not respond to the cue, then the method continues to discontinue presentment of the cue and continuing presentment of the television programming stream without presentment of a subsequent cue. Claim 1 is reproduced below:

> 1. A method for evaluating the performance of a viewer watching a television programming stream, comprising the steps of:
>
> *receiving a broadcast of the television programming stream, the television programming stream comprising a televised broadcast transmission of at least one of a live media session and a recorded media session*;
>
> *inserting an audio/video cue into the television programming stream,* the audio/video cue associated with content of the television programming stream such that the audio/video cue prompts the viewer during presentment of the television programming stream to provide an indicated response to an event within an indicated time period;
>
> *presenting the television programming stream and the audio/visual cue to a media delivery system device*;
>
> if the viewer responds to the cue within the indicated time period, then:
>
> detecting the indicated response to the event,;
>
> measuring a response time of the indicated response to the event, wherein the response time is the time between the time which event occurred and when the viewer provided the indicated response,;

> *evaluating viewer performance based upon the response time such that the response time associated with the viewer is compared to one of another response time to another event and an averaged response time of two or more other events*, and
>
> providing an incentive to the viewer based upon the viewer's performance.

U.S. Patent Application No. 10/036,677, claim 1 (currently amended) (emphasis added by Assignee).

Grossman does not disclose nor suggest these claim elements. *Grossman* describes a system and method for delivering *pre-recorded* interactive *marketing and advertising material* (*see* p.1, paragraph 2) (emphasis added by Assignee). Examiner Bui is correct — *Grossman* does describe receiving a "promotional program stream from an advertiser." *See* U.S. Patent Pub. No. 2002/0032906 A1 to Grossman, p1, paragraphs 12 & 13 ("delivers as its primary content, video commercials and infomercials" and other references to "commercial"). *Grossman*, however, fails to even remotely describe or suggest "receiving a broadcast of the television programming stream, the television programming stream comprising a televised broadcast transmission of at least one of a live media session and a recorded media session" as Claim 1 requires. Rather, *Grossman* discloses a viewer interactively accessing pre-recorded, stored promotional material. *See* U.S. Patent Pub. No. 2002/0032906 A1 to Grossman, p.2, paragraphs 25 & 26 ("video commercials and other promotional materials are *stored* by advertisers in the storage device" and accessed for viewing), p. 3, paragraphs 32 & 36 ("the viewer is presented with the ability to view *stored* commercials and infomercials") (emphasis added by Assignee); *see also* U.S. Patent Pub. No. 2002/0032906 A1 to Grossman, p. 4, paragraphs 41 & 45, claims 1 & 6, and FIGS. 1-3 and 5. *Grossman*, therefore, does not disclose or describe broadcast television media such as live and pre-recorded movies, sporting events, programs, and/or other televised broadcast media. *See* U.S. Application No. 10/036,677, p. 1, line 31, and p. 9, lines 1-2.

Further, *Grossman*, fails to even remotely describe other essential claim limitations such as (1) "inserting an audio/video cue into the television programming stream," (2) "presenting the

television programming stream and the audio/visual cue to a media delivery system device," and (3) if the viewer responds, then detecting the indicated response, measuring the response time, "evaluating viewer performance based upon the response time such that the response time associated with the viewer is compared to one of another response time to another event and an averaged response time of two or more other events." *See* amended claim 1.

Rather, *Grossman* discloses that:

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> [0040] The display of selected commercials will now be described with reference to the flow diagram of FIG. 3. In a preferred embodiment, the viewer earns rewards points *when a viewed commercial concludes*. . . .
>
> [0041] *After the viewer instructs the system to display a commercial* (step 800), the system builds a commercial and promotion page based from stored promotion data and downloads the page to the viewer's web browser (step 802). *The commercial is then played on the viewer's Internet device (step 804). The system tracks the playing of the streamed commercial on the user's computer (step 806) and adds rewards points associated with the video to the viewer's account* ***when the system has confirmation that the commercial has been completely played*** on the viewer's Internet device (step 808). *If promotional programs are also selected, then each promotional program is played on the viewer's Internet device (step 810) and the viewer receives additional rewards points for each promotion* ***completed by the viewer.***

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U.S. Patent Pub. No. 2002/0032906 A1 to Grossman, p.4, paragraphs 40 & 41 (emphasis added by Assignee). Consequently, *Grossman* requires the viewer to completely view the entirety of the commercial, advertisement, or promotional material.

For these reasons and others, *Grossman*, then, cannot anticipate claim 1 of this invention. And because claims 3, 5, 7, and 10-12 depend upon claim 15, *Grossman* cannot anticipate claims 3, 5, 7, and 10-12. Accordingly, Assignee respectfully requests Examiner Bui to withdraw the §102 rejection and allow the pending claims.

§103 Rejection:

The Office rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over Grossman (U.S. Patent Pub. No. 1002/0032906 A1) in view of Trewitt et al. (U.S. Patent No. 6,134,531), rejected claims 8-9 under 35 U.S.C. § 103(a) as being unpatentable over Grossman (U.S. Patent Pub. No. 1002/0032906 A1) in view of Rosser (U.S. Patent No. 6,446,261 B1), and rejected claims 13-14 and 16-22 under 35 U.S.C. § 103(a) as being unpatentable over Grossman (U.S. Patent Pub. No. 2002/0032906 A1) in view of Trewitt et al. (U.S. Patent No. 6,134,531)and in view of Rosser (U.S. Patent No. 6,446,261 B1). If the Office wishes to establish a *prima facia* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, the combination of *Grossman*, *Trewitt*, and/or *Rosser* again wholly fails teach or suggest the claim limitations. The Assignee, then, respectfully requests allowance of claims 4, 8-9, 13-14, and 16-18. Claims 19-22 have been cancelled, so the rejection of these claims is moot.

The combination of *Grossman*, *Trewitt*, and/or *Rosser* does not obviate the pending claims. *Grossman*, as mentioned above, describes a system and method for delivering *pre-recorded* interactive *marketing and advertising material* (emphasis added by Assignee). *Trewitt* describes method and apparatus for correlating real-time audience feedback to a segments of a broadcast programs using an Internet enabled device. And, *Rosser* describes an electronic device for inserting targeted indicia into live video signals. The combination of *Grossman*, *Trewitt*, and/or *Rosser* wholly fails to even remotely recite the limitations of claims 4, 8-9, 13-14, and 16-18. Neither *Grossman* nor *Truitt* nor *Rosser* teach or suggests the limitations of independent claim 1 from which 4 and 8-9 or of independent claim 13 from which 14 depends. Because the combination of *Grossman*, *Trewitt*, and/or *Rosser* fails to teach or suggest the limitations, these claims would not have been obvious to one of ordinary skill in the art. The Assignee, then, respectfully asks Examiner Bui to remove the § 103 rejection and to allow the pending claim.

CONCLUSION

All of the rejections have been overcome. Further, none of the references cited by Examiner Bui, alone or in combination, disclose or suggest the claimed invention. Therefore, Assignee respectfully solicits a Notice of Allowance for all pending claims (claims 1-18 and 23-24).

AUTHORIZATION FOR PAYMENT OF FEES

If there are any other fees due in connection with the filing of this response, please charge the fees to the credit card on file. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to the credit card on file.

If the Office has any questions, the Office is invited to contact the undersigned at (757) 253-5729 or bambiwalters@cox.net.

Respectfully submitted,

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